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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,331	08/23/2001	Erhard Honig	24759	9981

7590 03/18/2005

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EXAMINER

MUSSER, BARBARA J

ART UNIT PAPER NUMBER

1733

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/938,331

Applicant(s)

HONIG, ERHARD

Examiner

Barbara J. Musser

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) _____.

13. ☒ Other: see attachment.


SAM CHUAN YAO
PRIMARY EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): 102(b) over Cakmakci and 103 rejections over Munro and Winterroth et al., Munro, Winterroth et al., and Nakata et al., Munro, Winterroth et al., Nakata, et al. and Ecklund et al., and Munro, Winterroth et al.. and Hasenkamp et al. .

ATTACHMENT

Examiner agrees that the device of Cakmakci, while having the elements required by the claim, would not be able to extrude onto the edge of a workpiece without modification of the apparatus, and therefore this rejection is withdrawn.

Since the reasons of Winterroth et al. for applying ridges to the adhesive are not reasons that could be used in combination with Munro, the rejections wherein Munro is the primary reference have been withdrawn.

The rejections over Shanahan et al. stand.

Regarding applicant's argument that applicant's 1940 priority document fully supports applicant's invention, the priority document does not disclose extruding onto the edge of a workpiece, or the workpiece being particle board, chipboard, or a wood-like material. While examiner agrees that the device formed in the 1940 priority document would work in a tongue and groove joint, applicant's claims require the material to be extruded onto the edge of the workpiece while the material is still fluid as otherwise it would not be shaped by the forming means, the desired profile being formed by being squeezed between the workpiece edge and the forming means. This means the material is extruded directly from the extruder onto the edge of the workpiece while still in a fluid state. The device of 1940, on the contrary, is a solid piece which can be inserted into a groove, which may be in the edge of a workpiece. This does not in any way suggest forming the strip of material directly onto the edge of the workpiece rather than forming a preformed strip which is then applied to the edge of a workpiece. The 1940 priority document and the application are forming different articles.

Additionally, the priority document does not teach the workpiece being chipboard, particle board, or made of wood-like particles. Teaching a genus such as wood does not mean that applicant had possession of all the species such as chipboard, particularly since chipboard is not a type of wood, but rather is a product made from wood. The definition of wood does not include a material made by mixing wood particles with resins or binders. Finally, applicant's 1940 priority document does not disclose wood-like workpieces of any type. While these are examples, they are part of the claim, and all the claim language must be fully supported by the priority document for the application to claim support back to the priority document. The type of workpiece provides a structural context for the apparatus and if all the language related to the workpiece and its edge were removed, the rejection under Cakmakci would be valid.

As to all applicant's arguments that the secondary references combined with Shanahan et al. do not teach a forming means having protrusions or recesses, the forming means of Shanahan et al. teaches such.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571)-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BJM


SAM CHUAN YAO
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